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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			POON, KING Y	
			ART UNIT	PAPER NUMBER
			2624	40

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/991,855

Applicant(s)

KII ET AL.

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 16 December 1997 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 38.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said data for the fixed form reply" in line 10. There is insufficient antecedent basis for this limitation in the claim.

It is unclear whether the "said data for the fixed form reply" is the "data for a set of fixed form replies" of line 3, or data for just one fixed form reply out of the set of fixed form replies.

Claim 7 recites the limitation "said data for the fixed form reply" in line 9. There is insufficient antecedent basis for this limitation in the claim.

It is unclear whether the "said data for the fixed form reply" is the "data for a set of fixed form replies" of line 4, or data for just one fixed form reply out of the set of fixed form replies.

Claim 9 recites the limitation "said data for the fixed form reply" in lines 9, 12, 13, 16. There is insufficient antecedent basis for this limitation in the claim.

It is unclear whether the "said data for the fixed form reply" is the "data for a set of fixed form replies" of line 5, or data for just one fixed form reply out of the set of fixed form replies.

Claim 13 recites the limitation "data for the first fixed form reply" in lines 10, and "the first data for the first fixed form reply" of line 13. There is insufficient antecedent basis for this limitation in the claim.

It is unclear whether the "said data for the fixed form reply" and the "the first data for the first fixed form reply" are the "data for a first set of fixed form replies" of line 5, or data for just one fixed form reply out of the first set of fixed form replies.

Claim 17 recites the limitation "said data for a reply" in lines 11-12. There is insufficient antecedent basis for this limitation in the claim.

It is unclear whether the "said data for a reply" is the "data for a set of fixed form replies" of lines 4-5, or data for just one fixed form reply out of the set of fixed form replies.

Regarding claims 2-6, 8, 10-12, 14-16, 18-20: Claims 2-6, 8, 10-12, 14-16, 18-20 are rejected under 35 U.S.C. 112, second paragraph because they depend on rejected claims 1, 7, 9, 13, and 17.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 26, 27, 28, 29, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Peters (US 5,893,098).

Regarding claim 26: Peters teaches a method of managing an electronic message having a message content and reply choices (fig. 6) to the electronic message, comprising: storing data (# 102 of fig. 13, fig. 6, bulletin board of column 3 line 5-15, and column 37 line 59-65) for a set of fixed form replies (e.g., column 16, lines 45-55) in advance of the electronic message (the question could be entered after the reply, column 17, lines 25-35, column 18, lines 40-45) and the replies having a reply contents independent of the content of the electronic message (column 17, lines 25-35, teaches that the message and the reply are independently entered) allowing use of the fixed form reply with other electronic message (column 17, lines 40-45, teaches rely "yes" to message "leave" is also used together with message "destination" or column 16, lines 10-12); outputting (the program that controls the transmitting of survey document, column 8, lines 35-45) the electronic message with the stored data for the fixed form replies, selecting, subsequent to inputting the electronic message, certain of the outputted fixed form replies as the reply choices to the message (fig. 6).

Regarding claim 27: Peter teaches a fixed form reply managing means (collation mean, column 8, lines 63) for managing the fixed form replies by data for respectively specifying the plurality of replies, (the survey document and its data, column 8 line 63-68, column 9 line 1-19) and totaling means (adding, column 4, lines 25-27, of the reply

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data is equivalent to the teaching of using a totaling means in Peter's system because the function of a totaling mean is to add, and Peter would need a totaling means for performing the addition) for totaling a number of the selection of the fixed form replies as the reply choice to the message, and storing results of the totalization of each of fixed form replies to the message in relation to said specifying data. (graphic plot with added and manipulated data, column 4 line 25-27).

Regarding claim 28: Peters teaches a method of managing an electronic message having message content (column 14, lines 19-32) comprising: storing replies (# 102 of fig. 13, fig. 6, column 3, lines 64-68, column 4, lines 30-45, column 16, lines 45-55) for the electronic message (column 14, lines 19-32) with the replies having reply contents independent of the content of the electronic message (column 17, lines 25-35, teaches that the message and the reply are independently entered) allowing use of the fixed form reply with other electronic message (column 17, lines 40-45, teaches rely "yes" to message "leave" is also used together with message "destination"); receiving the electronic message and presenting the electronic message to a recipient (respondents column 19, lines 5-25); presenting the replies to the recipient and allowing the recipient to select one of the replies; (e.g., fig. 6) and sending the selected one of the replies (column 8, lines 47-55).

Regarding claim 29: Peters teaches a method of managing an electronic message having message content (column 14, lines 19-32) comprising: pre-creating content independent reusable set of replies (on selection data values chosen automatically, column 15, lines 60-67, column 16, lines 1-15; column 16, lines 45-55;

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the on values would be yes, no, or not sure and would be reused by other questions); and allowing a recipient (respondent, column 4, lines 30-45) of an electronic message (question, column 15, lines 5-10) to select one of the set of replies (select yes, no or not sure out of the set of reply contains yes, no, or not sure, column 16, lines 45-55) as the reply to the electronic message.

Regarding claim 30: Peter teaches an electronic news system (fig. 13) for managing electronic messages (see the question of options that best describes a vehicle of fig. 6) having a message content and a reply, (see fig. 6) comprising: storage means (# 102 of fig. 13, fig. 6, bulletin board of column 3 line 5-15, and column 37 line 59-65) for storing data for a set of fixed form replies, (e.g., column 16, lines 45-55) independent (column 17, lines 25-35, teaches that the message and the reply are independently entered) of the content of a first electronic message (e.g., column 15, lines 1-3) sending the first electronic message (the program that controls the transmitting of survey document, column 8, lines 35-45); selecting a response (e.g., user selects yes, no, or am not sure, column 16, lines 45-55) from the stored data for the set of fixed form replies having contents independent of the content of the first electronic message; sending a second electronic message (other type of questions); selecting a response (e.g., user selects a reply corresponds to the field values; note the field values represents the response of the reply, column 16, lines 1-15) from the stored data for the set of fixed form replies having contents independent of the content of the second electronic message.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21, 22, 24, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peter et al. (U.S. Patent # 5893098) and Pinter (U.S. Patent # 5894506).

Regarding claims 21: Peter et al teaches a message system (fig. 1) for an electronic message having a message content (column 14, lines 24-30) comprising: a reply data storage device storing a plurality of fixed form replies set (see bulletin board and column 3 line 1-13) containing a plurality of replies (e.g., fig. 6) and having a reply contents independent of the content of the electronic message (column 17, lines 25-35, teaches that the message and the reply are independently entered) allowing use of the plurality of fixed form reply sets with other electronic message (column 17, lines 40-45, teaches rely "yes" to message "leave" is also used together with message "destination"); an input device (the entering device for the author used to edit the question, column 14, lines 30-50, column 15, lines 1-30) for inputting the electronic message without

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information about a reply to the message; a controller (the control of the computer used as a bulletin board, e.g., # 1 of fig. 1) for receiving the message from a host (2, fig. 1, abstract) and allowing a user to retrieve a reply from the selected fix form reply set (see column 4, lines 35-40) stored in the reply data storage device, the fixed form reply set independent of the message (e.g., fig. 8) inputted in advance of the message (the question could be entered after the reply, column 17, lines 25-35, column 18, lines 40-45); and an output device (the control controlling transmitting of data, column 8, line 53) outputting the selected reply to the host. (See column 8 line 53, abstract).

Peter does not specifically disclose that the message and the reply data are stored separately.

However, Pinter, in the same area of managing an electronic message and a reply to the message, (abstract, column 1, lines 40-65, column 2, lines 1-35) teaches to store a reply data (response options, column 2, lines 34) separately from a message (canned messages, column 2, lines 14, column 1, lines 40-50; the canned messages are stored in a canned message file, column 1, lines 50-67, and the response options are stored in a multiple response options file, column 2, lines 23-27, column 5, lines 15-20).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to have modified the electronic system of Peter by: storing the reply data separately from the message.

It would have been obvious to a person having ordinary skill in the art at the time of invention to have modified Peter by the teaching of Pinter because of the following

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reasons: (a) it would have allowed a user to retrieve and display the message and question quickly, and would have been helpful for the user, (b) it would have allowed the system being easily maintained and altered, (c) it would have provided an improved electronic message system, as taught by Pinter, at column 1, lines 35-40, and (d) storing the "reply data" and the "message" separately provides the advantages of keeping easy inventory of the reply to each message and allowed the user(s) to keep track of each reply and each message in a separate file. Thereby, the reply and the message can be easily managed and accessible to the user(s).

Regarding claim 22: Peter teaches that the selection of a fixed form reply set is based on a category (yes or no to "do you like chocolate", column 4, lines 30-50) of the message.

Regarding claim 24: Peter teaches wherein the host receives a plurality of the outputted selected fixed form replies and displays a bar graph illustrating a frequency of responses. (See column 4, lines 24-27, fig. 12, column 20, lines 40-67, column 21, lines 1-10)

Regarding claim 25: Peter teaches a computer readable storage medium storing a computer program (column 10 line 1-35) instructing computers to perform operations for an electronic message having a message content, (column 14, lines 24-30): storing a plurality of fixed form replies set (see bulletin board and column 3, line 1-13), each fixed form reply set containing a plurality of replies and each set having a reply contents independent of the content of the electronic message (column 17, lines 25-35, teaches that the message and the reply are independently entered) allowing use of the fixed

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form reply sets with other electronic message (column 17, lines 40-45, teaches rely "yes" to message "leave" is also used together with message "destination"); inputting (new question menu and the area for question text, column 12, lines 55-61) the electronic message without information about a reply to the message;(fig. 6) storing the message, (see bulletin board and column 3 line 1-13, yes of the question "do you like chocolate", column 4, lines 30-45) the message being inputted after the fixed form reply set (the question could be entered after the reply, column 17, lines 25-35, column 18, lines 40-45); receiving the message (column 4, lines 30-50) from a host; (2, fig. 1, abstract) selecting a reply from the selected fix form reply set (yes, or no, column 4, lines 25-50) independent of the message (e.g. fig. 8); allowing a user to choose a reply from the selected fixed form reply set; (column 4, lines 25-50); sending the chosen reply to the host (column 8, lines 53).

Peter does not specifically disclose that the message and the reply data are stored separately.

However, Pinter, in the same area of managing an electronic message and a reply to the message, (abstract, column 1, lines 40-65, column 2, lines 1-35) teaches to store a reply data (response options, column 2, lines 34) separately from a message (canned messages, column 2, lines 14, column 1, lines 40-50; the canned messages are stored in a canned message file, column 1, lines 50-67, and the response options are stored in a multiple response options file, column 2, lines 23-27, column 5, lines 15-20).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to have modified the electronic system of Peter by: storing the reply data separately from the message.

It would have been obvious to a person having ordinary skill in the art at the time of invention to have modified Peter by the teaching of Pinter because of the following reasons: (a) it would have allowed a user to retrieve and display the message and question quickly, and would have been helpful for the user, (b) it would have allowed the system being easily maintained and altered, (c) it would have provided an improved electronic message system, as taught by Pinter, at column 1, lines 35-40, and (d) storing the "reply data" and the "message" separately provides the advantages of keeping easy inventory of the reply to each message and allowed the user(s) to keep track of each reply and each message in a separate file. Thereby, the reply and the message can be easily managed and accessible to the user(s).

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peters and Pinter as applied to claim 21 above and further in view of Ginter et al. (U.S. Patent # 5982891).

Regarding claim 23: Peter teaches to select a text and still picture as free form reply. (Fig. 6)

Peter in view of Pinter do not teach to select speech, sound, and moving pictures as free form reply.

Ginter et al. teach that usage information used in a survey (see column 36 line 30-40) transmitted from one party to another can be selected from speech, sound, and moving pictures. (See column 58, line 55-65).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Peter in view of Pinter: by selecting the free form reply to be represented in forms of speech, sound, and moving pictures.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Peter in view of Pinter by the teaching of Ginter et al. because of the following reasons: (a) selecting electronic information to be represented in forms of speech, sound, and moving pictures would have allowed the information being easily understood by a user and would be helpful for the user in making the reply.

Response to Arguments

8. Applicant's arguments filed 8/28/2003 have been fully considered but they are not persuasive.

With respect to applicant's argument that Peter's reply cannot be used by other questions has been considered.

In reply: Column 18, lines column 16, lines 45-55, Peters, teaches a set of fixed form reply (yes, no and not sure) that inherently can be used by all questions that requires a yes, no, and not sure answer. Furthermore, column 17, lines 25-35, column 18, lines 25-40, Peters teaches to prepare the fixed form reply prior to the entering of

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the question. Therefore, Peters, teaches the prepared fixed form reply can be use with any questions that the author entered.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892 or to Supervisor Mr. David Moore whose phone number is (703) 308-7452.

6/9/04

King Y. Poon